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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/018,316	08/05/2003	Derek Whitaker	0091-0207P	1645

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EXAMINER

BASINGER, SHERMAN D

ART UNIT	PAPER NUMBER
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3617

DATE MAILED: 10/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/018,316	Applicant(s) WHITAKER ET AL.	
	Examiner Sherman D. Basinger	Art Unit 3617	<i>NW</i>

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 September 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 15 is/are allowed.
- 6) ☒ Claim(s) 1-14 and 16-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 September 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 14 and 20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

3. A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claim 14 recites the broad recitation "mating interconnection means", and the claim also recites preferably "a male connection means and a female connection means" which is the narrower statement of the range/limitation.

4. Claim 20 is ambiguous because in parent claim 19 that the first plank and the second plank are curved is claimed and in claim 20 that the first and second planks are planar is claimed. The planks cannot be curved and planar at the same time.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 9, 10 and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by Jaspert.

The shape conforming surface is shown in figure 1.

The planks of flexible material are planks 3. Planks 3 are made of wood which is a flexible material. The longer the planks 3 are the more flexible they will be. All wooden planks or boards have flexibility, more so when of a longer length.

Planks 3 due to their flexibility will be able to be laid in curved formations if so desired.

Since the boards 3 are of wood, they have a grain effect of wood and are roughened by nature so as to imitate this unique grain effect of wooden material.

The intermediate caulking strips are shown in figure 3. The planks are of a color and luster which is of a grain of a wooden material, so they imitate the color and luster of a grain structure of a wooden material. The caulking strips, being rubber are of a different color.

The caulking strips and the planks 3 have the male and female connection parts.

7. Claims 18, 20, 21, 24 and 25 are rejected under 35 U.S.C. 102(b) as being anticipated by Jaspert.

The shape conforming surface is shown in figure 1. The interconnected flexible first and second planks are 3. Planks 3 are of wood. Wood has flexibility. The longer the plank the more flexible it will be. The caulking of a second width less than the first width and formed between the first and second planks is 7.

The first and second planks are planar. (Claim 20 is rejected as best understood.)

Since the planks 3 are wood, they have a wood grain texture.

The surface of the planks 3 is considered to be roughened. The surface of wood is roughened when compared to a glass surface.

8. Claims 18, 19, 21, 22 and 24 are rejected under 35 U.S.C. 102(b) as being anticipated by Fincher.

The shape conforming surface covering is shown in figure 3. The interconnected, flexible, first and second planks having a first width are planks b. Since the planks are of wood, they are flexible. Wooden planks have flexibility. The longer the planks, the more flexible they are.

The caulking strip is a. The caulking strip a has a width less than that of the planks b.

As shown in figure 3, the first and second planks are curved.

Since the planks b are of wood, they will have a wood grain texture.

Claim Rejections - 35 USC § 103

9. Claims 1-4, 6, 7, 8, 16 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zwilgmeyer in view of Anstadt.

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Zwilgmeyer discloses surface coverings planar planks 2 interconnected aside of each other as is shown in 1 and which are of a material which is flexible such that planks 2 can be laid in curved formations (see column 3, lines 55-end). The planks of Zwilgmeyer are not roughened at the upper surface of the covering so as to imitate any unique grain effect of wooden material.

Anstadt discloses imitation wood work pieces roughened on at the upper surface (see column 3, lines 1-6) so as to imitate any unique grain effect of wooden material.

It would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains to roughen the planks 2 of Zwilgmeyer in a manner similar to that taught by Anstadt to give the planks a wood grain look. Motivation to do so would be to make the boat being manufactured in figure 3 of Zwilgmeyer look like a boat made from wood.

With regard to claim 2, Anstadt teaches the use of sanding in column 4, lines 27-30.

Thus, it would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains to use sanding to create the wood gain look on the boards 2 of Zwilgmeyer. To sand the boards of Zwilgmeyer to create the desired wood gain look by sanding in the longitudinal direction of sanding only discrete sanding portions extending at an oblique angle to the longitudinal direction of the plank would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Motivation to do so is to create a particular type of wood grain look which is pleasing to the eye of the person creating the wood grain look.

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With regard to claim 6, note column 4, lines 43-end of Anstadt. Thus, it would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains in view of what is taught by Anstadt to form the planks of Zwilgmeyer with streaks or lines of color included in the extrusion to further imitate the grain in wood. Motivation to do so is to produce a look closer to the desired wood grain.

With regard to claim 7, note the number of uses for the planks 2 of Zwilgmeyer. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains to use the planks of Zwilgmeyer in view of what is disclosed in column 1, lines 8-13 for all of the uses set forth in claim 7.

Motivation to do so is to make each of these structures using a plank that is easily manufactured by extrusion.

It would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains to make the planks 2 of Zwilgmeyer look like oak wood grain in view of column 4, lines 20-25 of Anstadt.

Motivation to do so is to have the boat being made with the planks look like it is made of oak.

As shown in figure 1 of Zwilgmeyer the planks have matching male and female means at opposite longitudinal edges for interconnecting the same.

The rigid material filling the planks of Zwilgmeyer is foam 4 (see column 2, line 57).

Foam 4 of Zwilgmeyer is also the light weight foam material filling planks 2 from the underside-see figure 1.

10. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Zwiłgmeyer and Anstadt as applied to claim 1 above, and further in view of Hunter et al. The planks of Zwiłgmeyer are made of PVC which includes glass fiber reinforcement. Zwiłgmeyer does not disclose adding additives for UV protection and fire retardance. UV protection is added to the workpieces of Anstadt as a lacquer. Hunter adds flame retardants, thermal stabilizers, lubricants, plasticizers, pigments, fillers and other commonly available additive material in fabricating his panels (see column 5, lines 15-20).

It would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains in view of the teachings of Anstadt and Hunter et al to add as additives to the material used in making the planks of Zwiłgmeyer both fire retardants and UV protection. Motivation to do so is to create a plank that is both weather and fire resistant.

11. Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fincher in view of Zwiłgmeyer.

The planks b of Fincher are not formed of pvc. Zwiłgmeyer discloses planks formed of pvc. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains to form the planks of Fincher of pvc. Motivation to do so is that plastic is used to form planks because it is cheaper to make the planks of plastic than to make them from wood, plastic is lighter and stands up to the environment much better.

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12. Claims 11, 12, 13 and 26 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Jaspert.

Jaspert discloses the claimed shape conforming surface covering comprising flexible planks 3 which can be laid in a curved formation if so desired, the planks having an upper surface which is roughened by nature so as to imitate a unique grain effect of wood as the planks are wood, and caulking 7.

Claims 11, 12, 13 and 26 are product by process claims do to the following limitations:

"characterized in that the covering is extruded in sheet form having co-extruded caulking strips" of claim 11,

"characterized in that the covering is extruded in sheet form having recesses for later inserting of caulking strips in the recesses" of claim 12,

"characterized in that the covering is a co-extrusion of planks and integral caulking strips" of claim 13,

and "wherein said first plank, said second plank, and said caulking strip are co-extruded".

Determination of patentability of these claims is based upon the product itself.

Jaspert anticipates the product. Therefor, claims 11, 12, 13 and 26 are anticipated by Jasper.

Or, in the alternative, the shape conforming surface defined in claims is unpatentable over Jasper. Jasper discloses the shape conforming surface with the claimed planks and caulking. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains to make the

shape conforming surface of claims 11, 12, 13 and 26 by the process of extruding the covering in sheet form having co-extruded caulking strips, extruding in sheet form the covering having recesses for later inserting of caulking strips in the recesses, co-extruding the covering as a co-extrusion of planks and integral caulking strips, and co extruding the first and second planks and the caulking strip. Motivation to do so is to form the conforming surface in a cheap and effective way.

Allowable Subject Matter

13. Claim 15 is allowed.

Response to Arguments

14. New grounds of rejection have been set forth in this office action with regard to claims 9-14. Thus claims 9-14 are not allowed. Claim 15 is still allowed.

15. Applicant argues with regard to claim 1 that the planks of Zwilgmeyer are not planar. This argument is not persuasive because the planks of Zwilgmeyer are planar until they are curved. The planks 2 of Zwilgmeyer are planar planks adapted to be interconnected aside of each other, and the planks 2 of Zwilgmeyer are of a material that can be laid in curved formations. Applicants attention is directed toward column 1, lines 62-end. The planks of Zwilgmeyer are bent relatively easy into the desired curved shape. Absent the planks being planar, there would be no need to bend them.

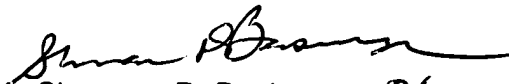
16. New claims 18-26 have been rejected with new prior art.

Conclusion

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sherman D. Basinger whose telephone number is 703-308-1139. The examiner can normally be reached on M-F (6:00-2:30 ET).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Samuel J. Morano can be reached on 703-308-0230. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Sherman D. Basinger
Primary Examiner
Art Unit 3617
10/5/04

sdb
10/5/04